

**THIS DISPOSITION
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10/24/00

Paper No. 12

HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Society of Certified Insurance Counselors

Serial No. 75/284,126

H. Dale Langley, Jr. of Akin, Gump, Strauss, Hauer & Feld,
L.L.P. for applicant.

Patricia A. Horrall, Trademark Examining Attorney, Law
Office 106 (Mary Sparrow, Managing Attorney).

Before Walters, Chapman and Wendel, Administrative
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

The Society of Certified Insurance Counselors has
filed an application to register the mark depicted below
for "educational services, namely, conducting classes,
seminars and conferences in the field of insurance and risk
management and distributing course materials in connection
therewith."¹

¹ Serial No. 75/284,126, filed April 30, 1997, with a claimed
first use date and first use in commerce date of August 1996.

Registration has been finally refused under Section 6(a) of the Trademark Act, 15 USC § 1056(a), on the basis of applicant's failure to comply with the requirement that a disclaimer be entered of the words THE NATIONAL ALLIANCE FOR INSURANCE EDUCATION & RESEARCH apart from the mark as a whole.

The refusal has been appealed and both applicant and the Examining Attorney have filed briefs. No oral hearing was requested.

The Examining Attorney maintains that the word portion of applicant's mark is merely descriptive of applicant's services and accordingly not registrable standing alone. She argues that this combination of terms immediately informs consumers of the nature, scope and subject matter of the services at hand, namely, that applicant's services originate from a national alliance formed to advance education and research in the insurance industry. To support her position, she had made of record a dictionary definition of "alliance"² and copies of several third-party

² The definition relied upon from *The American Heritage Dictionary of the English Language* (3rd ed. 1992) reads in relevant part:

alliance 1. a. a close association of nations or other groups, formed to advance common interests or causes: *an alliance of labor unions opposing the bill.*

registrations in which the terms "national" and "alliance" have been disclaimed.

Applicant insists that the wording is at most suggestive of applicant's services; that the separate terms "national," "alliance," "insurance," "education" and "research" have general meanings which are subject to wide variation and thus the language could be perceived as relating to many types of services. Applicant further argues that the mark must be considered in its entirety and as such the words must be considered in context with the fanciful design portion of the mark.

A term or phrase is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys information about a characteristic or feature of the goods or services with which it is being used. Whether or not a particular term is merely descriptive is not determined in the abstract, but rather in relation to the goods or services for which registration is sought, the context in which the designation is being used, and the significance the designation is likely to have, because of the manner in which it is used, to the average purchaser as he encounters the goods or services bearing the designation. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

We find the evidence made of record by the Examining Attorney, together with the specimens, fully adequate to establish that the wording THE NATIONAL ALLIANCE FOR INSURANCE EDUCATION & RESEARCH is merely descriptive when used in connection with applicant's educational services. The statements are made in the specimens that "The Society of Certified Insurance Counselors (CLC), along with the Society of Certified Insurance Service Representatives (CISR), Certified Risk Managers (CRM) International, and The Academy of Producer Insurance Studies, comprise The National Alliance for Insurance Education & Research" and that "We are national in scope." Taking these statements along with the dictionary definition of the term "alliance" as a "close association ... of groups, formed to advance common interests," we find that the term NATIONAL ALLIANCE immediately and directly conveys information with respect to the nature of the organization from which applicant's services originate. The third-party registrations relied upon by the Examining Attorney merely corroborate the descriptive nature of the term "alliance, " particularly when used in connection with groups offering educational services. The remaining terms INSURANCE EDUCATION & RESEARCH clearly refer to the specific topics and scope of

programs and resources offered by applicant in connection with its educational services.

Applicant's arguments that the individual terms in this wording have various general meanings, and that, even when used in this combination, the wording could have various interpretations carry little weight. We set forth the general principle above that descriptiveness is not determined in the abstract, but rather as the term or phrase is being used in connection with the particular services involved. As pointed out by the Examining Attorney, the present language is merely descriptive if it immediately conveys information to purchasers as to the nature of applicant's services, when they encounter the mark being used with these services. The question is not whether these purchasers would be able to decipher what the services are upon viewing the wording alone. We have no doubt that purchasers would immediately grasp the descriptiveness of the wording as being used by applicant.

Applicant's further argument that since a mark must be considered in its entirety, the wording must be viewed in the context of the design, is equally unpersuasive. Clearly the design has no impact on the connotation of the wording which is being used therewith. The design is purely ornamental. Thus, we fail to see how the design

could have any effect on the determination of the descriptive nature of the wording in itself.

Accordingly, the refusal to register applicant's mark on the basis that a disclaimer of the wording THE NATIONAL ALLIANCE FOR INSURANCE EDUCATION & RESEARCH must be entered is affirmed. Pursuant to Trademark Rule 2.142(g), this decision will be set aside and applicant's mark will be published for opposition if applicant, no later than thirty days from the mailing date hereof, submits a disclaimer of the wording THE NATIONAL ALLIANCE FOR INSURANCE EDUCATION & RESEARCH apart from the mark as a whole.

Decision: The refusal to register without the entry of a disclaimer, as set forth above, is affirmed.

C. E. Walters

B. A. Chapman

H. R. Wendel
Administrative Trademark Judges,
Trademark Trial and Appeal Board

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